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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,274	12/09/2003	Martin Sawicki	60001.287US01	4979
27488	7590	05/01/2006	EXAMINER	
MERCHANT & GOULD (MICROSOFT)			BOTTS, MICHAEL K	
P.O. BOX 2903			ART UNIT	
MINNEAPOLIS, MN 55402-0903			PAPER NUMBER	
			2176	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/731,274	SAWICKI ET AL.	
	Examiner	Art Unit	
	Michael K. Botts	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/17/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on December 9, 2003.
2. Claims 1-28 have been examined, with claims 1, 10, and 19 being the independent claims.
3. Claims 1-28 are rejected.

Information Disclosure Statement

4. A signed and dated copy of applicant's IDS, which was filed on May 17, 2004, is attached to this Office Action.

The Specification

5. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.
6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-6, 9, 19-24, and 26-28** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-6, 9, 19-24, and 26-28 are directed to nonfunctional descriptive material. See, MPEP 2106.IV.B.1.

Regarding **claims 1-6 and 9**:

Independent claim 1 currently recites computer-executable components on a computer-readable medium that are “arranged to . . .” Claims 2-6 and 9 inherit the rejection of claim 1 through their dependency on claim 1, and claims 2-6 and 9 do not remedy the grounds for the rejection. There is no functional relationship imparted by this data to a computing device. The claim describes software per se recorded on memory. Therefore, the claim is drawn to non-functional descriptive material which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. 101 for the manufacture. See, MPEP 2106.IV.B.1.

Regarding **claims 19-24 and 26-28**:

Independent claim 19 currently recites computer-executable components on a computer-readable medium that are “arranged to . . .” Claims 20-24 and 26-28 inherit

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the rejection of claim 19 through their dependency on claim 19, and claims 20-24 and 26-28 do not remedy the grounds for the rejection. There is no functional relationship imparted by this data to a computing device. The claim describes software per se recorded on memory. Therefore, the claim is drawn to non-functional descriptive material which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. 101 for the manufacture. See, MPEP 2106.IV.B.1.

In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1, 6-10, 15-19, and 25-28** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by DeRose, et al. (U.S. Patent 5,557,722, issued September 17, 1996) [hereinafter “DeRose”).

Regarding **independent claim 1**, DeRose teaches:

A computer-readable medium having computer-executable components, comprising:

a first component that is arranged to edit an electronic document having editable objects;

(See, DeRose, col. 7, line 15 through col. 30, line 18, teaching editing electronic documents.)

a second component that is arranged to define a first location for the start of an editable object region for which a level of editing permission for a specific user is desired and to define a second location for the end of the editable object region;

(See, DeRose, col. 7, line 15 through col. 12, line 9, teaching a first location ("start tags") for an object region ("text chunks."). See also, DeRose, col. 8, line 61 through col. 9, line 9, teaching editing permission as "security for the document.")

a third component that is arranged to associate a user identifier for the specific user with the text region that is defined by the first and second locations;

(See, DeRose, col. 12, line 10 through col. 13, line 16, teaching a second location ("end tags") for the text region ("text chunks").)

and a fourth component that is arranged to encode in an ML format the electronic document, a first element that defines the first location, and a second element that defines the second location, wherein one of the first and second

element further comprises the user identifier.

(See, DeRose, col. 7, line 15 through col. 30, line 18, teaching the use of Standard Generalized Markup Language (SGML) as the markup language (ML) to encode the electronic document defined by the first and second locations (start and end tags).)

Regarding **dependent claim 6**, DeRose teaches:

The computer-readable medium of Claim 1, wherein the first and second elements are imbedded in the ML-encoded electronic document at the first and second locations respectively.

(See, DeRose, col. 7, line 15 through col. 24, line 51, teaching the first and second elements embodies as "start tags" and "end tags.")

Regarding **dependent claim 7**, DeRose teaches:

The computer-readable medium of Claim 1, further comprising a fifth component that is arranged to output an ML file that comprises the ML-encoded electronic document and the first and second elements.

(See, DeRose, figures 4 and 12-14, and col. 7, lines 15-39, teaching output devices enabled by the invention including display monitors and printers.)

Regarding **dependent claim 8**, DeRose teaches:

The computer-readable medium of Claim 7, wherein the first element and the second element comprise a unique identifier by which the first and the

second element are associated having a one-to-one correspondence.

(See, DeRose, col. 10, line 57 through col. 11, line 7, teaching tag attributes including corresponding start and end tags and locations. See also, DeRose, col. 9, lines 6-9, teaching tag attributes including security designations.)

Regarding **dependent claim 9**, DeRose teaches:

The computer-readable medium of claim 1, wherein the unique identifier is encoded with a level of editing permission that is to be panted to the specific user identified by the user identifier.

(See, DeRose, col. 9, lines 6-9, teaching tag attributes including security designations.)

Regarding **independent claims 10 and 19**:

Claims 10 and 19 incorporate substantially similar subject matter as claimed in claim 1 and are rejected along the same rationale.

Regarding dependent **claims 15 and 25**:

Claims 15 and 25 incorporate substantially similar subject matter as claimed in claim 6 and are rejected along the same rationale.

Regarding dependent **claims 16 and 26**:

Claims 16 and 26 incorporate substantially similar subject matter as claimed in claim 7 and are rejected along the same rationale.

Regarding dependent **claims 17 and 27**:

Claims 17 and 27 incorporate substantially similar subject matter as claimed in claim 8 and are rejected along the same rationale.

Regarding dependent **claims 18 and 28**:

Claims 18 and 28 incorporate substantially similar subject matter as claimed in claim 9 and are rejected along the same rationale.

9. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. **Claims 2, 3, 11, 12, 21, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose as applied to claim 1 above, and further in view of Ayers, L., "AbiWord's Potential," Linux Gazette, Issue 43, July 1999, downloaded by the Examiner on December 20, 2005, from: www.linuxgazette.com/issue43/ayers.html, downloaded pages 1-4, [hereinafter "Ayers"].

Regarding **dependent claim 2**, DeRose in view of Ayers teaches:

The computer-readable medium of claim 1, wherein the electronic document is a word-processor document.

(DeRose teaches the limitations of claim 1, but does not expressly teach the use of the invention in a markup language based word processor.

Ayers teaches the XML based word processor "AbiWord."

DeRose and Ayers are combinable because they both involve the same art of markup language manipulation of electronic documents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of DeRose with Ayers for the obvious and beneficial advantage of delimiting sections of text in a word processing environment with access limitations.

The suggestion for doing so would have been from the fact that DeRose recognizes the connection between a word processor for the creation of an electronic document for use with the markup language invention. See, DeRose, col. 8, lines 26-37, teaching that the markup language of the invention may use a word processor.

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Starting with a word processor to produce the markup language initially is an obvious and logical savings of one step in the invention process.

Therefore, it would have been obvious to combine DeRose with Ayers to obtain the invention as specified in claim 2.

Regarding **dependent claim 3**, DeRose in view of Ayers teaches:

The computer-readable medium of Claim 2, wherein the editable objects comprise one of paragraphs, characters, tables, images, rows, cells, columns, text, and objects native to the application.

(The rejection of claim 2 is incorporated by this reference. In addition, see, DeRose, teaching the editable objects of text, etc. as "text chunks.")

Regarding **dependent claims 11 and 21**:

Claims 11 and 21 incorporate substantially similar subject matter as claimed in claim 2 and are rejected along the same rationale.

Regarding **dependent claims 12 and 22**:

Claims 12 and 22 incorporate substantially similar subject matter as claimed in claim 3 and are rejected along the same rationale.

Regarding **dependent claim 20**, DeRose in view of Ayers teaches:

The system of claim 19, wherein the electronic document is stored in a

proprietary format.

(It is noted that the limitation of storing the electronic document in a “proprietary format” is not expressly defined or taught in the specification, which describes the limitation within the context of an unclaimed “editor process,” stating: “The document can be stored in a proprietary format of the editor process.” See, disclosure, page 12, lines 4-5.

The claimed limitation term “proprietary format” is read as being consistent with the disclosed term “proprietary format of the editor process.” The Examiner understands the claim term to mean that which was known to one of ordinary skill in the art at the time of the invention as “A program owned or copyrighted by an individual or a business and available for use only through purchase or by permission of the owner.” See, “Microsoft Computer Dictionary,” Fifth Edition, Microsoft Press, 2002, definition of “proprietary software.” The claim limitation “proprietary format” will be defined as stated above for the remainder of this Office Action.

The Examiner takes official notice of the fact that electronic documents, including markup language electronic documents, were, at the time of the invention, stored within programs of a proprietary format, such as within commercially available programs. An example of such commercial proprietary software program being AbiWord, as described and discussed in Ayers. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the electronic document within a commercially available proprietary software format, for the purposes of ordinary document storage, later retrieval, sale, distribution, transportation, etc.

11. **Claims 4, 5, 13, 14, 23, and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose as applied to claim 1 above, and further in view of Takata, et al. (U.S. Patent 6,119,136, issued September 12, 2000) [hereinafter "Takata"].

Regarding **dependent claim 4**, DeRose in view of Takata teaches:

The computer-readable medium of Claim 1, wherein the electronic document is a spreadsheet document.

(DeRose teaches the limitations of claim 1, but does not expressly teach the use of the invention in a spreadsheet document.

Takata teaches the use of a spreadsheet for creating a markup language (HTML) document.

DeRose and Takata are combinable because they both involve the same art of markup language manipulation of electronic documents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of DeRose with Takata for the obvious and beneficial advantage of delimiting sections of an electronic document with access limitations.

The suggestion for doing so would have been from the fact that DeRose recognizes the connection between a word processor for the creation of an electronic document for use with the markup language invention. See, DeRose, col. 8, lines 26-37, teaching that the markup language of the invention may use a text editor. Takata teaches the use of a spreadsheet as a text editor. See, Takata, col. 1, line 66 through

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col. 4, line 37.

Therefore, it would have been obvious to combine DeRose with Takata to obtain the invention as specified in claim 4.

Regarding **dependent claim 5**, DeRose in view of Takata teaches:

The computer-readable medium of claim 4, wherein the editable objects are cells.

(The rejection of claim 4 is incorporated by this reference. In addition, see, Takata, col. 1, line 66 through col. 3, line 45.)

Regarding **dependent claims 13 and 23**:

Claims 13 and 23 incorporate substantially similar subject matter as claimed in claim 4 and are rejected along the same rationale.

Regarding **dependent claims 14 and 24**:

Claims 11 and 21 incorporate substantially similar subject matter as claimed in claim 5 and are rejected along the same rationale.

12. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon

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for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Conclusion

13. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Wang, et al. (U.S. Patent 7,028,009 B2), teaching document security.

Choy (U.S. Patent 6,141,754), teaching document security.

Worth (U.S. Patent 5,881,225), teaching access security on portions of an electronic document.

Hinsley, et al. (U.S. Patent 5,295,266), teaching access security for portions of an electronic file.

Individuals associated with the filing or prosecution of a patent application are reminded of their obligations pursuant to 37 CFR 1.56. See generally, MPEP 2001 and subsections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

A handwritten signature in black ink, appearing to read 'Doug Hutton', with a stylized flourish at the end.

**DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100**